REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application.

This Amendment is in response to the Office Action mailed February 4, 2009. In the Office Action, the Examiner rejected claim 10 under 35 U.S.C. §112, second paragraph; claims 1-4, 8-9, 13, and 15-20 under 35 U.S.C. §102(e); and claims 5-7, 10-12, and 14 under 35 U.S.C. §103(a). Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claim 10 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner states that "to be enabled and disabled" is unclear (Office Action, page 2). The Examiner states that there are several elements being recited to pertain to the enable and the disable. It is allegedly not clear when the enable and disable would occur, and which elements "to be enabled and disabled" applies to (Office Action, page 2). Applicant respectfully disagrees.

First, claim 10 recites, among other things, "a display interface decoder subsystem adapted... to be enabled and disabled; an input/output decoder subsystem adapted... to be enabled and disabled; a memory decoder subsystem adapted... to be enabled and disabled". As delineated in claim 10, each of the subsystems is adapted to be enabled and disabled. Accordingly, it is clear that the language "to be enabled and disabled" applies to each of the subsystems (a display interface decoder subsystem, an input/output decoder subsystem, and a memory decoder subsystem).

Furthermore, Applicant directs the Examiner's attention to the Specification, paragraphs [0023], [0024], and [0026].

Among other things, the specification recites:

> "FIG. 5 is an exemplary flow chart further illustrating the initializing process for a first media device 160 illustrated in block 410 of FIG. 4. As shown in FIG. 5, the process starts (block 500) and proceeds to enabling a decoding of a display interface on a path of the media device_1, including all upstream buses 105, such as PCI buses (block 510). In an exemplary embodiment of the invention, the display interface comprises a video graphics array (VGA) interface,

and the VGA decoding on the path of the media device_1 is performed by the display interface decoder 135 (shown in FIG. 1). Next, input/output decoding is enabled for the media device_1 (block 520), such as by media device_1, such as by using the Input/Output decoder 120 shown in FIG. 1. The input/output decoding is performed on the information stored in the I/O region 147c of FIG. 3A as described above." (See Specification, par. [0023], for further details). *Emphasis Added.*

"A memory decoding is then enabled for the media device_1 (block 530), such as by using the memory decoder 142 shown in FIG. 1." (See Specification, par. [0024], for further details). *Emphasis Added.*

"FIG. 6 is an exemplary flow chart further illustrating the initializing process for a second media device 160 illustrated in blocks 430 of FIG. 4. As shown in FIG. 6, the process starts (block 600) and proceeds to disabling the enabled decoding of the display interface on the path of the enabled media device_1, as previously illustrated in block 510 of FIG. 5 (block 610). The enabled input/output decoding for the media device_1 and the enabled memory decoding for the media device_1 are then disabled (blocks 620, 630). The input/output decoding and memory decoding for the media device_2 is enabled for the media device_2 (blocks 640, 650)." (See Specification, par. [0026], for further details). *Emphasis Added.*

Claims should be interpreted consistently with the specification, which provides content for the proper construction of the claims because it explains the nature of the patentee's invention. See Renishaw, 158 F.3d 1250. During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification". See MPEP 2111.

As delineated in the claim as well as in the specification, a display interface decoder subsystem, an input/output decoder subsystem, and a memory decoder subsystem may be enabled and disabled. Accordingly, Applicant respectfully submits that claim 10 is not unclear.

Second, claim 10 delineates a system comprising a display interface decoder subsystem, an input/output decoder subsystem, and a memory decoder subsystem. Each of these subsystems is "adapted… to be enabled and disabled" as delineated in claim 10. The system claim need not further delineate "when the enable and disable would occur" in order to meet the requirements of 35 U.S.C. §112, second paragraph.

Therefore, Applicant respectfully requests the rejection under 35 U.S.C. §112 be withdrawn.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-4, 8-9, 13, and 15-20 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0158828 issued to Zimmer et al. ("Zimmer"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of anticipation.

Zimmer does not disclose, either expressly or inherently, at least, the elements as recited in independent claims 1, 9, and 18.

Zimmer merely discloses, in a typical PC architecture, the BIOS being generally defined as the firmware that runs between the processor reset and the first instruction of the Operating System (OS) loader (Zimmer, par. [0003]). Typically, firmware code is stored in a "monolithic" form comprising a single set of code that is provided by a platform manufacturer or a BIOS vendor such as Phoenix or AMI. Various portions of the single set of code are used to initialize different <u>system components</u>, while other portions are used for run-time (i.e., post-boot) operations (Zimmer, par. [0004]). *Emphasis Added.*

In contrast, independent claims 1, 9, and 18 delineate: "initializing <u>a plurality of media</u> <u>devices</u> in communication with a computing device." *Emphasis Added.* The Examiner alleges that the system components correspond to the plurality of media devices in communication with the computing device (Office Action, page 3). Applicant respectfully disagrees. As delineated in the Specification, the term "media device" refers to any on-board or plug-in device, such as video cards, music players, or DVD players, for example, that is<u> capable of storing video or</u> <u>audio data, such as movies, songs, etc.</u>" (See Specification, par. [0013] for further details). *Emphasis Added.* There is no teaching that the system components initialized using various portions of the firmware code are <u>a plurality of media devices</u>.

Regarding claim 9, the Examiner alleges that Zimmer teaches "a plurality of media devices in communication with a computing device and adapted for initialization by the computing device", citing Zimmer, paragraph [0003]. Applicant respectfully disagrees and submits that Zimmer, paragraph [0003] states:

> "In a typical PC architecture, <u>the BIOS is generally defined as the</u>
> <u>firmware that runs between the processor reset and the first instruction of the</u>

Operating System (OS) loader. This corresponds to the startup operations performed during a cold boot or in response to a system reset. At the start of a cold boot, very little of the system beyond the processor and firmware is actually initialized. It is up to the code in the firmware to initialize the system to the point that an operating system loaded off of media, such as a hard disk, can take over" (Zimmer, par. [0003]). *Emphasis Added.*

As stated in Zimmer, BIOS is firmware. Since firmware is not a device capable of storing video or audio data, such as movies, songs, the BIOS cannot correspond to "a plurality of media devices."

Moreover, Zimmer merely discloses that, with reference to FIG. 1, in response to a cold boot or system reset, the instruction pointer of a computer system's microprocessor is directed to the first instruction in a set of platform initialization firmware code 110 that is stored on a firmware device (FD) 0. This firmware device, often referred to as the BIOS chip, comprise the boot firmware device (BFD) for the system. Execution of the platform initialization firmware begins at a reset code portion 112, and proceeds sequentially until all of the firmware to initialize the computer system has been executed (Zimmer, par. [0016]).

The Examiner alleges that Zimmer discloses the devices are being operated for booting up the system (Office Action, page 4) such that Zimmer allegedly teaches "operating the initialized media devices based on the mapped information corresponding to each operated media device while the computing device is in a pre-OS environment", as delineated in claims 1, 9, and 18. Applicant respectfully disagrees.

In the pre-boot in Zimmer, the computer's microprocessor is sequentially executing the instructions in the firmware code 110 that is stored in the BIOS chip to initialize the computer system. As discussed above, the term "media device" refers to a device that is capable of storing video or audio data, such as movies, songs, etc. Accordingly, executing firmware code 110 stored on the BIOS chip cannot correspond to "operating the initialized media devices" as delineated in the claims.

To anticipate a claim, the reference must teach every element of a claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of

<u>California</u>, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the…claim." <u>Richardson v. Suzuki Motor Co.</u>, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Since the Examiner failed to show that <u>Zimmer</u> teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

Therefore, Applicant believes that independent claims 1, 9, and 18 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §102(e) be withdrawn.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 5-7, 10-12, and 14 under 35 U.S.C. §103(a) as being unpatentable over <u>Zimmer</u> in view of U.S. Publication No. 2005/021058 issued to Cowperthwaite et al. ("<u>Cowperthwaite</u>"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, certain basic criteria must be met. For instance, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143.* Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." <u>MPEP 2141</u>. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order *to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at*

issue." *Emphasis Added.* The Court further required that an explicit analysis for this reason must be made. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR 127 S.Ct.* at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

As discussed above, <u>Zimmer</u> does not disclose or render obvious each and every element as recited in independent claims 1, 9, and 18. Accordingly, a combination of <u>Zimmer</u> with <u>Cowperthwaite</u> in rejecting claims dependent thereon is improper.

Therefore, Applicant believes that independent claims 1, 9, and 18 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: May 4, 2009   By /William W. Schaal/
William W. Schaal
Reg. No. 39,018
Tel.: (714) 557-3800 (Pacific Coast)

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040